

### REMARKS

In the Office Action dated September 11, 2007 (hereinafter "Office Action"), the Examiner makes an objection under 35 U.S.C. §132(a) to applicant's amendment filed on 11/7/05, allegedly because the amendment introduced new matter into disclosure. Furthermore, the Examiner rejects claims 1-5 under 35 U.S.C. § 112 alleging that the claims purportedly fail to comply with the written description requirement. The Examiner also rejects claims 1-4 under 35 U.S.C. § 102(b) alleging anticipation by Shoptaugh U.S. Patent 3,731,934. Finally, the Examiner rejects claims 3-5 and 6-13 under 35 U.S.C. §102(b) as allegedly anticipated by or, in alternative, under 35 U.S.C. §103(a) as allegedly obvious over Shoptaugh. Reconsideration and withdrawal of these rejections, and issuance of a Notice of Allowance is respectfully requested in light of the amendments to the claims set forth herein, which, it is respectfully submitted, place the case in a better form for the appeal and/or in condition for allowance, pursuant to 37 C.F.R. § 1.116, and the remarks set forth hereinbelow.

By way of background, applicant's invention is directed to a game for play by at least two players, where each of the players takes turns to make one of two possible moves: placing a new game piece in one of the apertures on one on one of the slats or linearly displacing one of the slats one stop. A gaming surface of said game provides three modes of play: a first mode wherein no gaming pieces are placed on the board at game commencement, a second mode wherein game pieces are added at the option of the players during play, and a third, game over mode wherein one of at least two players' game pieces are configured on said apertured slats in a predetermined arrangement, and wherein said gaming surface is structured such that it lacks home positions in any of said modes

for placement of said pieces. A winner is determined when a player arranges all of his game pieces in a predetermined configuration, such as four or eight in a row, or in a diamond.

With respect to the rejection under 35 U.S.C. § 132(a), applicant respectfully asserts that the reference to “home position” or “home area” in the amendments does not introduce a new matter into the disclosure of the invention. Specification and claims as originally presented describe a base assembly comprising slats. The fact that the language in the specification as originally filed does not mention a base containing home positions or home areas is in of itself an inference that said base does not contain home positions or areas. It is respectfully submitted that it would be unreasonable to require every applicant to disclose in the specification all possible things that are not included in the invention. Accordingly, the Examiner’s assertion that the reference to home positions is new material solely because the original disclosure is silent with respect to home positions being or not being should be withdrawn, and applicant should not be required to cancel the phrase in this reply.

With respect to the Examiner’s objection to claims 1-5 under 35 U.S.C. §112, as allegedly “failing to comply with the written description requirement,” applicant respectfully requests that, in light the arguments hereinabove, the Examiner reconsider this objection and consider the claims, as amended, as duly obviating these objections.

With respect to the Examiner’s concern under 35 U.S.C. § 102, applicant respectfully submits that the instant application is easily distinguishable from Shoptaugh. Specifically, Shoptaugh shows a game in which a player wins by moving all of the gaming pieces belonging to that player from one side of the game board (home position) to the other. The instant invention, on the other hand, discloses a game in which the players win by arranging their gaming pieces in

a predetermined arrangement on the board, thereby adding complexity to the game. Additionally, in distinction to Shoptaugh, in the present invention the players do not move the gaming pieces across the board, but instead may choose to place a new gaming piece on the board with each move. Furthermore, the rules of the game shown in Shoptaugh are clearly distinguishable from the game rules disclosed in the present invention. In Shoptaugh, each player is given a choice of moves - - either to move his gaming pieces across the board or to move sliders only belonging to him. To the contrary, the rules of the game disclosed in the present invention allow each player to either *place a new gaming piece* on the board or to move *either* slider, thus adding complexity to the game. Finally, the game board surface shown in Shoptaugh contains slats with barriers to constrain the movement of the gaming pieces across the board. Indeed, such structure would make it impossible for the players to arrange the gaming pieces in the predetermined configuration, as claimed in the instant invention. Clearly, the subject application and Shoptaugh describe separate and distinct inventions.

Thus, reconsideration and withdrawal of the rejection of anticipation based upon the Shoptaugh reference is respectfully solicited in light of the above amendments and remarks.

Lastly, the Examiner rejects claims 3-5 and 6-13 under 35 U.S.C. § 103(a) as being allegedly obvious over Shoptaugh. Applicant respectfully submits that the instant application as amended is not obvious over the above-referenced patent for the distinct reasons, set forth above and further expanded upon herein below, for purposes of clarification. The subject invention is directed to a game apparatus and method of play, whereby a winner is determined when a player has a predetermined number of game pieces in a predetermined arrangement (such as a diamond, square, or other arrangement) which is critical to the present invention. Additionally, a gaming

surface of the game disclosed in the present invention provides three modes of play: a first mode wherein no gaming pieces are placed on the board at game commencement, a second mode wherein game pieces are added at the option of the players during play, and a third, game over mode wherein one of at least two players' game pieces are configured on the board in a predetermined arrangement. Respectfully, none of these critically inventive elements are even hinted at, let alone shown by the prior art. To the contrary, Shoptaugh describes a game apparatus whereby a winner is determined by simply moving his playing pieces from one side of the board to the other before his opponent. In further contrast with the present invention, the gaming surface shown by Shoptaugh contains home areas located on opposing sides of the board for placement of the gaming pieces at the commencement of the game and at the end of the game. Thus, the game shown in Shoptaugh commences by placing the gaming pieces belonging to each of two players in the respective home areas on the board, whereas the game disclosed in the instant invention commences with no gaming pieces on the board. Accordingly, the differences between the subject matter contained in the subject invention and the prior art cited by the Examiner (Shoptaugh) are not obvious to one of skill in the art.

For the reasons indicated above, it is respectfully submitted that the instant patent application is not rendered obvious by Shoptaugh, and hence reconsideration and withdrawal of this rejection is respectfully solicited.

In view of the above, each of the claims in this application is believed to be in the immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

The Examiner's continued careful consideration of the subject application is appreciated.

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Respectfully submitted,



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